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| 09/772,280      | 01/29/2001  | Yves Fouillet        | GENSET.077CP1       | 9257             |

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EXAMINER

TUNG, JOYCE

ART UNIT PAPER NUMBER

1637

DATE MAILED: 02/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/772,280

Applicant(s)  
Fouillet et al.

Examiner  
Joyce Tung

Art Unit  
1637



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 16, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 37 is/are pending in the application.
- 4a) Of the above, claim(s) 33 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 25-32 is/are rejected.
- 7) ☒ Claim(s) 22-24 is/are objected to.
- 8) ☒ Claims 1-33 and 37 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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***Response to Amendment***

1. The amendment filed 12/16/2002 has been entered.
2. The rejection of claims 9-32 under 35 U.S.C. 112, second paragraph is withdrawn.
3. Claims 1-8 remain rejected under 35 U.S.C. 102(b) as being anticipated by Corbett et al. (5,270,183).

Corbett et al. disclose a method for the amplification of DNA sequence using polymerase chain reaction in a cyclically heating and cooling reaction in which the reaction mixture is into a stream of carrier fluid going through different temperature zones (See column 3, lines 21-37). A tube carrying the stream of carrier fluid is made from plastic tube (See column 2, lines 34-42). The plastic tube has the same function as the wells for receiving samples as recited in the limitations of claim 2. The cycling can be occurred between different temperature zones up to 40 times as recited in claim 4. The method is involved using detection means (See column 8, lines 14-16). The temperature zone is provided with thermostatically controlled heating/cooling means (See column 6, lines 54-59). This teaching is inherent that the heating/cooling means can be a metal bar as indicated in the specification (See pg. 4, line 20).

Applicants argue that Corbett et al. do not teach that liquid sample are continuously moved through at least one temperatures-regulated zone wherein the temperature regulated zone cycles between at least two temperatures. It is unclear what is meant by "one temperature-regulated zone" and further it is unclear what is meant by "one temperature-regulated zone

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cycles between at least two temperatures” Thus the teachings of Corbett et al. anticipate the limitations of claims 1-8 and the rejection is maintained.

4. Claims 9-21 and 25-32 remain rejected under 35 U.S.C. 102(e) as being anticipated by Taylor et al. (6,375,817).

Taylor et al. disclose a method for rapid, automated, microscale sample analysis (See the Abstract). The method involved depositing liquid sample volumes into a plurality of sample receiving regions on at least one mobile sample transport member (See column 10, lines 6-9), and moving sample transport member along a pathway such that said sample receiving region move through at least one temperature regulated zone upon which a thermal transfer member acts, wherein said thermal transfer member is capable of cycling between at least two temperatures (See column 12, lines 36-61) (as recited in the limitations of claims 9-10, and 19-21) The sample receiving regions comprise areas on a substrate which has well having thin hydrophilic film on the bottom (See column 15, lines 42-45) (as recited in claims 11-18). The method involves PCR reaction (See column 12, lines 36-61) (as recited in claims 25-32). The thermal cycles through two temperatures are from about 2 to about 35 times (See column 12, lines 36-61) (as recited in claim 26).

Applicants argue that claim 9 requires that the samples be deposited on a mobile transport member that is then moved along a pathway such that the sample continuously moves through at least one temperature-regulated zone (which cycles between at least two temperatures while the sample moves through the temperature regulated zone). However, based upon the teachings of

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Taylor et al. as set forth above, Taylor et al. do teach these limitations and the sample is not stationary in the capillary tube. Applicants argue that Taylor et al teach that various insulators present within or exterior to the capillary may be used to maintained a sample stationary while also permitting localized heating and/or cooling (See column 11, lines 17-19) and in order to completely heat or cool the sample, the sample needs to be stationary for a little while.

Applicants also argue that Taylor et al. do not teach moving continuously but claim 9 does not recite “continuously” and recites “at least one temperature regulated zone”. Taylor et al teach such device moving sample to temperature regulated zone and then removal away from the temperature regulated zone which would be a different temperature.

Thus, the teachings of Taylor et al. still anticipate the limitations of claims 9-21 and 25-32.

***Allowable Subject Matter***

5. Claims 22-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Summary***

6. No claims are allowable.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119 on Monday-Friday from 10:00 AM-6:00 PM.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

9. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1637 via the PTO Fax Center located in Crystal

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Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

<sup>J.T</sup>  
February 20, 2003

  
GARY BENZION, PH.D.  
SUPERVISORY PATENT EXAMINER  
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